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BRIAN R. WOODWORTH  
275 N. FIELD DRIVE  
DEPT. NLEG BLDG H-1  
LAKE FOREST IL 60045-2579

**COPY MAILED**

JAN 30 2006

**OFFICE OF PETITIONS**

In re Application of :  
Silkaitis, et al. :  
Application No. 10/783,640 :  
Filing Date: 5 May, 2003 :  
Attorney Docket No. 7135US03 :  
:

DECISION

This is a revised decision on the petition filed on 14 April, 2005, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

**(It is noted, however, that Petitioner appears unable to present a satisfactory showing to support a petition under 37 C.F.R. §1.181, and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)**

- (2) Thereafter, there will be no further reconsideration of this matter.

## BACKGROUND

The record reflects that:

- Petitioner Michael Crabb (Reg. No. 37,298) failed to reply timely and properly to a Notice of Missing Parts mailed on 13 May, 2004, with a reply due, absent extension of time, on or before 13 July, 2004;
- the application went abandoned after midnight 13 July, 2004;
- Notice of Abandonment was mailed on 9 February, 2005;
- Petitioner filed the instant petition on 14 April, 2005, and argued there that he had not received the Notice of Missing Parts and that he had examined his files and his docket and no such document and/or notation thereof was in evidence.

What the record also reveals, and Petitioner fails to mention, are that:

- the Notice of Missing Parts properly was mailed to the then-address of record, to wit: Steven F. Weinstock, Abbott Laboratories, 100 Abbott Park Road, Dept. 377/AP6A, Abbott Park, IL 60064-6008;
- as of 14 April, 2005, and the filing of the instant petition—which indicates no mailing address but rather a Customer Number 41155 set forth at the end of the paper and which number apparently is associated with the address set forth at the top of this paper, to wit: Brian R. Woodworth, 275 N. Field Drive, Dept. Nleg Bldg H-1, Lake Forest Il 60045-2579—Petitioner had not noticed the Office of a change of address;
- moreover, Petitioner did not so notice the Office of a change of address until 3 August, 2005, at which time Petitioner filed a Revocation/Power of Attorney.

Petitioner might review the Commentary at the Manual of Patent Examining Procedure (MPEP) Chapter 600 (specifically §601.03), Chapter 700 (specifically §711.03(c)), and Chapter 2000 (specifically §2001 and §2001.03).

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>)

### Allegations as to the Request to Withdraw the Holding of Abandonment

The courts have determined the requirements for properly supporting a petition seeking

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

withdrawal of a holding of abandonment.<sup>7</sup>

As the history set forth in the Background, above, clearly indicates, Petitioner has not satisfied these requirements.

### CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is dismissed.

### ALTERNATIVE VENUE

Petitioner's clear inability make a showing to support the instant petition leaves as Petitioner's only alternative to irretrievable abandonment a petition alleging unintentional delay under 37 C.F.R. §1.137(b).<sup>8</sup>

Therefore, Petitioner may wish to consider filing a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay.

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form provided and available online.)

Further correspondence with respect to this matter should be addressed as follows:<sup>9</sup>

By mail:      Commissioner for Patents<sup>10</sup>  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

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<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

<sup>8</sup> The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

<sup>9</sup> On July 15, 2005, the Central Facsimile (FAX) Number will change from (703) 872-9306 to (571) 273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/ola/preognitice/cfax062005.pdf>.)

<sup>10</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).

By FAX: IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions